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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/942,942 | 08/31/2001 | Robert Kasirer | 57177-018 | 8976 |
| 7590 03/03/2006 MCDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096 | | | EXAMINER RINES, ROBERT D | |
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| | | | 3626 | |

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Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 09/942,942 | Applicant(s) KASIRER ET AL. | |
| | Examiner Robert D. Rines | Art Unit 3626 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3/6/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

[1] This communication is in response to the patent application filed 31 August 2001. It is noted that this application benefits from Provisional Patent Applications Serial Nos. 60/230,218 filed 1 September 2000, 60/265,186 filed 30 January 2001, and 60/282,876 filed 11 April 2001. The IDS statement filed 6 March 2002 has been entered and considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

[2] Claims 14-20 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: a connection between the server and the Intermediate Care Facilities.

[A] Claims 15-20, when analyzed in the same manner described above with respect to claim 14, are also rejected under 35 U.S.C. 112 for omitting cooperative structural relationships.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

[3] Claims 1-3, 5-13, and 24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The basis of this rejection is set forth in a test of whether the invention produces a useful, concrete, and tangible result.

[A] For a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In claim 1 of the present case, the acts of "providing a network", "connecting workstations", "connecting vendors" and "providing workstations" does not represent a positive step towards a useful, concrete and tangible result. Specifically, the acts of "providing and connecting" do not actively produce the useful, concrete and tangible result of "providing services to an Intermediate Care Facility" as recited in the preamble of the claim. Therefore, claim 1 is rejected under 35 U.S.C. 101 for being directed to non-statutory subject matter.

[B] Claims 2-3 and 5, when analyzed in the same manner described above with respect to claim 1, also fail to represent an active step towards a useful, concrete, and tangible result.

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Therefore, claims 2-3 and 5 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

[C] In claim 6 of the present case, the acts of "providing workstations", "connecting workstations", and "connecting said network hub" does not represent a positive step towards a useful, concrete and tangible result. Specifically, the acts of "providing and connecting" do not actively produce the useful concrete and tangible result of "upgrading information processing" as recited in the preamble of the claim. Therefore, claim 6 is rejected under 35 U.S.C. 101 for being directed to non-statutory subject matter.

[D] Claims 7-13, when analyzed in the same manner described above with respect to claim 6, also fail to represent an active step towards a useful, concrete, and tangible result. Therefore, claims 7-13 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

[4] Claim 24 is rejected under 35 U.S.C. 101 because the claimed invention is directed to nonstatutory function descriptive material.

[A] Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the

invention, which permit the data structure's functionality to be realized. A claim for a computer program without the computer-readable medium needed to realize the computer's functionality is nonstatutory descriptive material (MPEP 2106-1(a)).

[B] In claim 24 of the present case, the applicant claims "a hidden copy of data and instructions". The examiner is interpreting "data and instructions" to be a computer program or software as is indicated later in the claim by the applicant's description "at least a portion of an application" (Claim 24, lines 2/3). Applicant's claim to "data and instructions" renders the claimed invention as directed toward non-statutory subject matter. Thus, claim 24 is rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[5] Claims 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Mayaud (United States Patent #5,845,255).

[A] As per claim 21, Mayaud teaches a method of processing information for use with clinical trials, comprising the steps of: a. removing patient identifying information from a Minimum Data Set file to produce a revised file (Mayaud; col. 18, lines 36-39); b. storing information from the revised file in a database (Mayaud; col. 18, lines 36-39); and c. retrieving information from said database in response to a user query (Mayaud; col. 22, lines 36-52).

[B] As per claim 22, Mayaud teaches that said user query is directed to identifying organizations having candidates for participation in a clinical trial (Mayaud; col. 22, lines 36-52).

[C] As per claim 23, Mayaud teaches in which said user query is directed to identifying organizations having candidates using a particular product or service (Mayaud; col. 22, lines 36-52).

[6] Claims 1-9 and 14-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Gershman et al., (United States Patent #6,401,085).

[A] As per claim 1, Gershman et al., teaches a method of providing services to an Intermediate Care Facilities (ICF) comprising the steps of: a. providing a network of workstations at the Intermediate Care Facility (Gershman et al.; col. 4, lines 43-65); b. connecting workstations on said network to a remote central server (Gershman et al.; col. 4, lines 43-65); c. connecting one or more vendors to said central server (Gershman et al.; col. 4, lines

43-65); and d. providing said workstations at the Intermediate Care Facility with access to only ones of said one or more vendors approved by said Intermediate Care Facility (Gershman et al.; col. 39, lines 28-35 and col. 41, lines 7-22).

[B] As per claim 2, Gershman et al., teaches said network is a wireless network (Gershman et al.; Abstract and col. 39, lines 48-54).

[C] As per claim 3, Gershman et al., teaches the step of providing a purchase order from said ICF to one or more of said vendors approved by said ICF (Gershman et al.; col. 40, lines 18-27).

[D] As per claim 4, Gershman et al., teaches the step of tracking vendor performance on each purchase order (Gershman et al.; col. 39, lines 62-67 and col. 40 lines 1-3).

[E] As per claim 5, Gershman et al., teaches the step of providing reports to said ICF on vendor performance (Gershman et al.; col. 39, lines 62-67 and col. 40, lines 1-3).

[F] As per claim 6, Gershman et al., teaches a method of upgrading information process capability at Intermediate Care Facilities, comprising the steps of: a. providing workstations at an Intermediate Care Facility (Gershman et al.; col. 4, lines 43-65); b. connecting said workstations to a network hub (Gershman et al.; col. 4, lines 43-65); c. connecting said network hub to a central applications service provider (Gershman et al.; col. 40, lines 21-27 and col. 44, lines 49-63).

[G] As per claim 7, Gershman et al., teaches said network hub is a wireless hub (Gershman et al.; col. 39, lines 48-54).

[H] As per claim 8, Gershman et al., teaches the applications service provider provides at least one application from the set of applications consisting of: Vendor Compliance Software, Electronic Procurement Software, Clinical Compliance Software, Clinical Assessment Software, Mobile Connectivity Software, Clinical Trials Software, Census Enhancement Software, MDS Manager Software, Physician Order Software (Gershman et al.; col. 47, lines 20-30).

[I] As per claim 9, Gershman et al., teaches the applications service provider further provides at least one application from the set of applications consisting of: Billing Software, Inventory Management Software, Accounts Payable Software, Accounts Receivable Software, Billing Software and Accounting and Financial Software (Gershman et al.; col. 47, lines 20-30 and col. 59, lines 52-62).

[J] As per claim 14, a server for connection to at least one Intermediate Care Facility, comprising: a. a storage area network (Gershman et al.; col. 39, lines 45-61, col. 40, lines 18-27, and col. 43, lines 47-55); b. a plurality of application servers operating in a load sharing mode (Gershman et al.; col. 40, lines 18-27); c. a network interface (Gershman et al.; col. 40, lines 34-45); and d. a rules engine for processing information provided by one or more applications (Gershman et al.; col. 42, lines 41-50, col. 42, lines 62-67, and col. 43, lines 1-7).

[K] As per claim 15, Gershman et al., teaches said rules engine drives one or more of said applications (Gershman et al.; col. 44, lines 66-67 and col. 45, lines 1-7).

[L] As per claim 16, Gershman et al., teaches said rules engine links data and functions of one or more applications (Gershman et al.; col. 44, lines 66-67 and col. 45, lines 1-7).

[M] As per claim 17, Gershman et al., teaches said rules engine comprises rules of a rules hierarchy in which rules inherit properties from other rules higher in the hierarchy (Gershman et al.; col. 44, lines 66-67 and col. 45, lines 1-7).

[N] As per claim 18, Gershman et al., teaches said rules engine comprises rules having a scope of application that applies to an enterprise or subdivision of an enterprise, to facilities and to institutions (Gershman et al.; col. 40, lines 18-27).

[O] As per claim 19, Gershman et al., teaches the server adapted to be connected to one or more suppliers of goods or services (Gershman et al.; col. 40, lines 18-27).

[P] As per claim 20, Gershman et al., teaches in which said applications include one or more applications from the set of applications consisting of: Vendor Compliance Software, Electronic Procurement Software, Clinical Compliance Software, Clinical Assessment Software, Mobile Connectivity Software, Clinical Trials Software, Census Enhancement Software, Resident

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Scheduling, MDS Manager Software, Physician Order Software (Gershman et al.; col. 47, lines 20-30 and col. 59, lines 52-62).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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[7] Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gershman (United States Patent #6,401,085) in view of Mayaud (United States Patent #5,845,255).

[A] As per claim 10, Gershman teaches providing workstations (Gershman et al.; col. 4, lines 43-65). Gershman et al., further teaches connecting said workstations to a central applications service provider that provides procurement applications (Gershman et al.; col. 40, lines 21-27 and col. 44, lines 49-63). Gershman et al., fails to expressly disclose providing clinical applications from the central applications service provider.

[i] However, Mayaud teaches providing integrated clinical (Mayaud; col. 5, lines 4-24) and procurement applications (Mayaud; col. 20, lines 5-12).

[ii] It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Gershman et al., with those of Mayaud. The motivation to combine would have been to provide a system for electronic prescription creation by a prescriber at the point of patient care, said prescription being usable by a pharmacist to dispense drugs (Mayaud; col. 4, lines 30-35). Further motivation would have been to provide the prescriber with the option of select and prescribe a drug and then transmit the created prescription to authorized parties for fulfillment (Mayaud; col. 20, lines 5-13).

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[B] As per claim 11, Gershman et al., teaches the applications service provider provides at least one application from the set of applications consisting of: Vendor Compliance Software, Electronic Procurement Software, Clinical Compliance Software, Clinical Assessment Software, Mobile Connectivity Software, Clinical Trials Software, Census Enhancement Software, MDS Manager Software, Physician Order Software (Gershman et al.; col. 47, lines 20-30 and col. 59, lines 52-62).

[8] Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gershman et al., and Mayaud as applied to claim 10 above, and further in view of Bruynsteen (United States Patent #6,658,663).

[A] As per claim 12, Mayaud teaches a set of clinical and procurement applications (Mayaud; col. 4, lines 30-35 and col. 20, lines 5-13). However, Mayaud fails to teach the user selects application and pays a fee based on the number and/or type of applications selected.

[i] However, charging a fee for enhancing a computer's capability via updating or upgrading software or applications via a network is old and well known in the art as is evidenced by Bruynsteen (Bruynsteen; col. 1, lines 60-67).

[ii] As per claim 13, Bruynsteen teaches in which the fee is due periodically (Bruynsteen; col. 1, lines 60-67).

[9] Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gershman et al., in view of Grube (United States Patent #6,026,366).

[A] As per claim 24, Gershman et al., teaches a workstation for connection to a central server of an application service provider. However, Gershman et al., fails to specifically teach a hidden copy of data and instructions comprising at least a portion of an application provided by said central server whereby said workstation can continue to provide functionality to users when a communication link to said central server is not operational.

[i] However, Grube teaches a hidden copy of data and instructions comprising at least a portion of an application provided by said central server whereby said workstation can continue to provide functionality to users when a communication link to said central server is not operational (Grube; Abstract and col. 2, lines 20-27).

[ii] It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Gershman et al., and Grube. The motivation to combine would have been to receive software that compliments software currently contained in the computer or network without requiring computer or network users to continually monitor for new releases (Grube; col. 2, lines 20-27).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert D. Rines whose telephone number is 571-272-5585. The examiner can normally be reached on 8:30am - 5:00pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

R.D.R.

R.D.R. 11/14/05

Joseph Thomas
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SUPERVISORY PATENT EXAMINER